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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/075,747	02/14/2002	Frederick Growcock	11836.0703.NPUS00 (MIDR 7)	9474
27551	7590	05/19/2004	EXAMINER WARE, DEBORAH K	
STEPHEN H. CAGLE HOWREY SIMON ARNOLD & WHITE LLP 750 BERING DRIVE HOUSTON, TX 77057			ART UNIT 1651	PAPER NUMBER

DATE MAILED: 05/19/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/075,747	GROWCOCK ET AL.	
	Examiner Deborah K. Ware	Art Unit 1651	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 02 October 2003.
- 2a) This action is **FINAL**. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 25-57 and 59-65 is/are pending in the application.
- 4a) Of the above claim(s) 25-51 is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 52-57 and 59-65 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) All b) Some * c) None of:
1. Certified copies of the priority documents have been received.
2. Certified copies of the priority documents have been received in Application No. _____.
3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) Notice of References Cited (PTO-892)
- 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) Notice of Informal Patent Application (PTO-152)
- 6) Other: _____.

DETAILED ACTION

Claims 25-57 and 59-65 are presented for reconsideration on the merits.

Papers

The amendment filed March 1, 2004, has been received and entered.

Election/Restrictions

Claims 25-51 remain withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected inventions, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in Paper No. dated July 18, 2003. Applicants further present arguments and request reconsideration in paper dated March 1, 2004, however, for reasons of record and as follows the restriction is maintained. Applicants' argument that the elected invention is utilized in each of the claimed methods is noted. However, each method appears not to be using the elected claimed composition. Each method is different from the other and does not necessarily require the elected composition and further one way distinctness is well founded between each of the claimed method groups and the composition. The claimed elected composition can be used in a different method altogether wherein the elected composition can be used in a method of feeding since it reads on a feed composition or even a culture product per se. Also each of the claimed methods require different steps and do not necessarily require the claimed elected composition as argued by Applicants and thus, are found in different classes and subclasses. For this reason restriction is proper between the composition and methods. The materials required of the elected composition claims are not required to carry out the methods.

Therefore, the ~~request~~ to withdraw the restriction requirement is noted and has been reconsidered but remains final as noted of record in the Office action of October 2, 2003. However, it is possible that claims can be recombined once allowable subject matter has been determined in a case, although the claims to be recombined may be required to be amended in accordance with the subject matter.

Claim Rejections - 35 USC § 112

Claims 52-57 and 60-65 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Applicant's arguments filed March 1, 2004, have been fully considered but they are not persuasive. The argument that the independent claims 52 speaks for itself is noted, however, the claims are confusing for the language recited describing what the oil contaminated solids include as their composition per se. It is unclear whether the oil contaminated solids are composed of solid material coated with both an oleaginous phase of linear paraffin and a non-oleaginous phase? Also it is confusing whether or not the non-oleaginous phase is merely a salt of a biodegradable anion or something more than that per se? Also it is unclear whether a drilling fluid is the intended oil contaminated solids? The metes and bounds of the claims are unclear for those reasons of record. The Markush type language used in new claim 64 is also suggested for claims claim 53, 54, 55 and 61.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 52-57 and 59-65 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sicotte et al, previously cited, in view of newly cited Ritter et al. (US Pat No. 6,458,294-see enclosed PTO-892 Form).

Claims and Sicotte et al are discussed of record in the previous Office action of October 2, 2003, note page 4, all lines. Sicotte et al clearly teach a bulking agent, compostable nitrogen source, oil contaminated solids, drill cuttings, pretreated materials.

Ritter et al teach a plurality of worms for treatment of organic waste material, such as for example, sewage sludge. Note column 1, lines 1-25. Further, Ritter et al teach vermiculture and vermicast.

The claims differ from Sicotte et al in that a plurality of worms is not disclosed.

It would have been obvious to one of ordinary skill in the art at the time the claimed invention was made to add to the composition as disclosed by Sicotte et al a plurality of worms to form a vermiculture and vermicast as disclosed by Ritter et al. Clearly vermiculture compositions are known and well recognized in the cited prior art. Each of the claimed ingredients are well recognized and known by the cited prior art. To combine well known ingredients of the prior art is a clear *prima facie* case of obviousness and one of skill would have been motivated to combine a compostable nitrogen source such as sewage sludge with worms as the same is disclosed by Ritter et al. Further, Sicotte et al also disclose sewage sludge can be added to the mixture, note column 5, lines 5-15.

Sicotte et al clearly disclose drill cuttings and contaminated soil, etc. Also Sicotte disclose wood shavings as the viable bulking agent source, note column 16, line 47. Sicotte et al also disclose the presence of a moisture content and to modify the moisture of a composition is well within the purview of an ordinary artisan, note column

12, lines 65-67. With all of the carbon material that would be expected to be contained by the composition of Sicotte et al, a carbon to nitrogen ratio of about 25:1 is clearly an expected resultant ratio amount.

The moisture content of about 75% would be expected to provide successful results and may be desirable since Sicotte et al teach that their moisture content would drop and periodic misting was required. To adjust the moisture content is an obvious modification of the cited prior art. Also pretreated materials are also disclosed by Sicotte et al, note column 4, lines 40-41. Furthermore, to combine vermicast and drill cuttings is also an obvious modification of the cited prior art since one of skill would have been motivated to add to biodegraded drill cuttings more organic material, such as vermicast. In addition, the presence of oil contaminated solids such as those of drill cuttings, etc., would have been expected to include oleaginous and non-oleaginous phases of paraffins and salts as well as emulsifying agents left behind by the drilling fluids. Therefore, in the absence of evidence to the contrary the claims are rendered *prima facie* obvious over the cited prior art.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not

mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

All claims fail to be patentably distinguishable over the state of the art discussed above and cited on the enclosed PTO-892 and/or PTO-1449. Therefore, the claims are properly rejected.

No claims are allowed.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Deborah K. Ware whose telephone number is 571-272-0924. The examiner can normally be reached on 9:30-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mike Wityshyn can be reached on 571-272-0926. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

dkw
Deborah K. Ware
May 14, 2004

dkw
DEBORAH K. WARE
ART. UNIT 1651